



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuaki WATANABE, et al
Serial No.: 10/001,256 Group No.: 1714
Filed: November 2, 2001 Examiner.: Callie E. Shosho
For: INK COMPOSITION FOR INK JET PRINTER

Attorney Docket No.: U 013698-2

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Applicants hereby petition under 37 CFR 1.181 to withdraw the holding of
abandonment in the notice mailed September 8, 2006.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Date: September 13, 2006

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

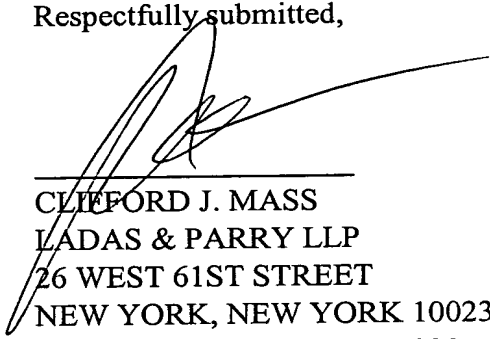
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"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

The notice erroneously states that the period for seeking court review of the Board of Patent Appeals and Interference decision of March 30, 2006 expired, but Applicants respectfully note that they filed a Request for Rehearing on May 30, 2006 as evidenced by the attached PAIR printout, which shows that the Board rendered a decision on the Request for Rehearing on July 28, 2006. A copy of the decision is also attached.

Under applicable rules, Applicants have two (2) months from the Board's decision, i.e., until September 28, 2006, to file a notice of appeal to the Court of Appeals for the Federal Circuit (see 37 CFR 1.304(a)(1)). That period has not yet run. Accordingly, the notice of abandonment is erroneous and should be withdrawn.

Respectfully submitted,



CLIFFORD J. MASS
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10/001,256

Ink composition for ink jet printer

Select New Case

Application Data

Transaction History

Image File Wrapper

Foreign Priority

Published Documents/Attorney/Agent

Transaction History

Date	Transaction Description
09-08-2006	Mailing of Abandonment after Board of Appeals
09-05-2006	Abandonment after Board of Appeals
07-28-2006	Mail BPAI Decision on Reconsideration - Denied
07-28-2006	Dec on Reconsideration - Denied
05-30-2006	Request for Reconsideration of Appeal Dec
03-30-2006	Mail BPAI Decision on Appeal - Affirmed
03-30-2006	BPAI Decision - Examiner Affirmed
02-08-2006	Request for Oral Hearing
02-08-2006	Request for Oral Hearing
02-08-2006	Confirmation of Hearing by Appellant
01-27-2006	Notification of Appeal Hearing
11-23-2005	Notification of Appeal Hearing
06-23-2005	Assignment of Appeal Number
05-24-2005	Appeal Awaiting BPAI Docketing
05-19-2005	Mail Reply Brief Noted by Examiner
05-19-2005	Mail Miscellaneous Communication to Applicant
05-16-2005	Miscellaneous Communication to Applicant - No Action Count
05-16-2005	Reply Brief Noted by Examiner
03-02-2005	Information Disclosure Statement (IDS) Filed
01-27-2005	Request for Oral Hearing

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3

03-02-2005	Date Forwarded to Examiner
01-27-2005	Reply Brief Filed
11-22-2004	Mail Examiner's Answer
11-19-2004	Examiner's Answer to Appeal Brief
09-20-2004	Date Forwarded to Examiner
09-13-2004	Appeal Brief Filed
09-13-2004	Request for Extension of Time - Granted
06-30-2004	Notice of Appeal Filed
06-30-2004	Request for Extension of Time - Granted
06-01-2004	Mail Advisory Action (PTOL - 303)
05-28-2004	Advisory Action (PTOL-303)
05-19-2004	Date Forwarded to Examiner
05-10-2004	Amendment after Final Rejection
05-10-2004	Request for Extension of Time - Granted
05-10-2004	Workflow incoming amendment IFW
01-29-2004	Mail Final Rejection (PTOL - 326)
01-22-2004	Final Rejection
11-24-2003	IFW Amended case processing Complete
11-24-2003	Date Forwarded to Examiner
11-10-2003	Response after Non-Final Action
11-10-2003	Request for Extension of Time - Granted
11-10-2003	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received
07-07-2003	Mail Non-Final Rejection
06-30-2003	Non-Final Rejection
03-04-2002	Information Disclosure Statement (IDS) Filed
11-02-2001	Information Disclosure Statement (IDS) Filed
04-01-2002	Case Docketed to Examiner in GAU
03-20-2002	Application Dispatched from OIPE
03-20-2002	Application Is Now Complete
02-15-2002	Payment of additional filing fee/Preexam
02-15-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic
12-28-2001	Notice Mailed--Application Incomplete--Filing Date Assigned

12-19-2001 IFW Scan & PACR Auto Security Review
12-07-2001 IFW Scan & PACR Auto Security Review
11-02-2001 Initial Exam Team nn

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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

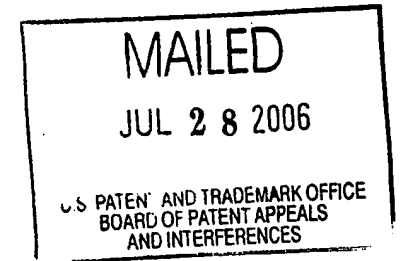
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUAKI WATANABE,
SHINICHI KATO AND
BUNJI ISHIMOTO

Appeal No. 2005-1629
Application No. 10/001,256

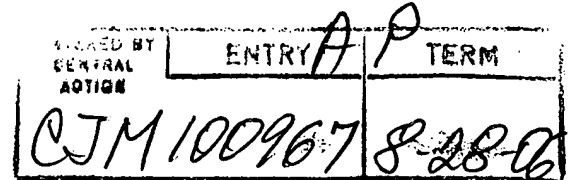
HEARD: MARCH 23, 2006



Before WARREN, WALTZ, and FRANKLIN, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

REQUEST FOR REHEARING

This is a decision on appellants' Request for Rehearing (hereafter "Request") dated May 30, 2006, submitted under the provisions of 37 CFR § 41.52 (2005), where appellants request rehearing of the merits panel Decision dated March 30, 2006 (hereafter the "Decision"). The Decision affirmed the examiner's rejections of claims 1, 3 and 8 through 10 under 35 U.S.C. § 103(a) as unpatentable over JP '525 or Anton, each in view of Sano (Decision, page 3).



Appeal No. 2005-1629
Application No. 10/001,256

Appellants request rehearing based on four issues, labeled as I, II, III and IV on pages 2-7 of the Request. We do not find appellants' arguments regarding these issues to be persuasive of error in our Decision. We present our reasoning in support of this determination below, treating each issue in the order presented in the Request.

With regard to issue I, appellants argue that the Board has misapprehended the teachings in Sano, "which do **not** suggest that the subject penetrating agent is useful for other ink compositions" but rather is specifically directed to alginate-containing ink compositions (Request, pages 2-3, citing Sano, col. 4, ll. 24-29, and col. 7, ll. 21-36). This is the identical argument presented by appellants in their Brief, Reply Brief, and Supplemental Reply Brief (see the sentence bridging pages 5 and 6 of the Decision), and we incorporate our response from the Decision (pages 6-8). Appellants have not argued or disputed the rationale espoused in our Decision, namely that Sano teaches the balancing or trade-off of properties for all additives, especially penetrants, in ink compositions (*id.*). We further note that appellants have cited but not disputed the teaching of Sano that penetrating agents were used before in certain critical concentrations to attain enhanced penetrating power that lessens

color bleeding, but with the use of alginates it is not necessary that the penetrating power be raised as high as for conventional ink compositions (Decision, page 7, citing Sano, col. 7, ll. 21-36). This teaching of Sano would have clearly led one of ordinary skill in the art to use the penetrants taught by Sano in conventional ink compositions, varying the amounts to obtain any desired properties.¹ We have also noted that the claims on appeal are not limited to any specific amount of "ultra-penetrating agent" (Decision, page 8, footnote 4). Accordingly, we have determined that it would have been obvious to one of ordinary skill in this art at the time of appellants' invention to have used the penetrating agents taught as preferred by Sano in place of common penetrants in conventional ink compositions, with the amount of penetrating agent needed readily determined by the artisan depending on the properties desired (Decision, pages 7-8).

With respect to issue II, appellants argue that, in light of Anton's teaching that the type of surfactant must be carefully

¹We note that Sano tests the claimed penetrating agent in inks without alginates, with results similar in most examples to inks with alginates (see the comparative examples at col. 17, ll. 52-65, and Table 1). We also note that these non-alginate containing inks were tested with the low amounts of the claimed penetrant used in the corresponding examples of Sano.

selected to avoid negative effects, there could be no motivation for one of skill in the art to select a type of surfactant from Sano (Request, page 4). This argument is not persuasive for the same reasons as discussed above and in the Decision at pages 6-8, namely that any use of a surfactant/penetrant involves a balancing or trade-off of properties such as enhanced color vs. lessening color bleeding. Anton at col. 8, ll. 40-46, merely teaches a similar balancing of properties as taught by Sano. Furthermore, as discussed above and in the Decision (page 8), the amount of penetrant used will greatly influence the desired properties.

With regard to issue III, appellants argue that Sano describes the claimed penetrating agent as being preferred only for alginate-containing inks, and thus there would have been no expectation of improved results for other ink compositions (Request, page 5). Additionally, appellants argue that even if the expectation of improved properties extended to other ink compositions, there was no expectation of advantageous properties such as improved cohesion differential, gloss differential, glossiness, and ejection stability (*id.*, citing the Watanabe Declaration filed Nov. 10, 2003).

Regarding appellants' first argument, we adopt our remarks from the Decision and above concerning the use of the preferred penetrant taught by Sano as not limited to alginate-containing inks, but the use of the claimed penetrant in conventional (or non-alginate containing) inks would have been obvious to one of ordinary skill in this art. With regard to appellants' argument concerning the specific properties tested in the Watanabe Declaration, we note that Sano tests for many desired properties (col. 16, l. 36-col. 18, l. 29), some of which are the same or similar to the properties found in the Watanabe Declaration (e.g., "stably jetted" at col. 18, l. 49, as well as "head clogging" at col. 17, ll. 7-23, vs. ejection stability in the Declaration (see the specification, page 35); "feathering" of the print at col. 16, ll. 36-52, and color bleeding at col. 16, ll. 53-67, which we assume is similar to the "cohesion differential" shown in the Declaration).² The glossiness properties tested for in the Declaration would have been expected from the use of the preferred surfactant (penetrant) taught by Sano, even though not described per se, since a surfactant would have been expected to increase the surface active properties of any ink composition.

²The "cohesion differential" was never defined in the specification (pages 32-33) or the Watanabe Declaration.

Appeal No. 2005-1629
Application No. 10/001,256

Regardless, the discovery of a property inherent to a composition cannot be the basis for patentability. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

With regard to issue IV, appellants argue that the two findings raised by the Board with respect to the evidence "were not raised in the prosecution of this application or in the Examiner's Answer and thus constitute new ground(s) for rejection" (Request, page 7, citing *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995)). This argument is not persuasive for several reasons. First, we note that the examiner's reliance on the finding that the improved results would have been expected from the teachings of Sano alone would be sufficient to rebut appellants' showing of evidence. See *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) (Decision, page 9). Secondly, the burden is on appellants to establish that the submitted comparative evidence is commensurate in scope with the claimed subject matter, the comparison is with the closest prior art, and there is only one variable whose cause and effect is sought to be shown. See *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Int. 1992). Whether or not the examiner finds that the comparative

Appeal No. 2005-1629
Application No. 10/001,256

evidence is not persuasive for any reason, the appellants still have the burden of establishing that the showing is with the closest prior art, commensurate in scope with the subject matter sought to be patented, and that the results are truly unexpected. Appellants have had ample opportunity to meet this burden.

Third, the citation of *In re Soni* is not controlling here since the court in *Soni* held that new rationales or arguments cannot be made on appeal to the Federal Circuit (54 F.3d at 751, 34 USPQ2d at 1688). Furthermore, our Decision has no new "rationale" but merely finds additional deficiencies in appellants' rebuttal evidence.

For the foregoing reasons and those stated in the Decision, we find no error in fact or law in the Decision. Furthermore, we do not find any cause for a new ground of rejection. Accordingly, we have considered appellants' Request for Rehearing and such Request is denied.


Appeal No. 2005-1629
Application No. 10/001,256

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv) (2004).

DENIED

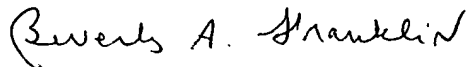


CHARLES F. WARREN)
Administrative Patent Judge)



THOMAS A. WALTZ)
Administrative Patent Judge)

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Administrative Patent Judge)

TAW/TF

Appeal No. 2005-1629
Application No. 10/001,256

LADAS & PARRY
26 WEST 61 STREET
NEW YORK, NY 10023



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Practitioner's Docket

U 013698-2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuaki WATANABE, et al
Serial No.: 10/001,256 Group No.: 1714
Filed: November 2, 2001 Examiner.: Callie E. Shosho
For: INK COMPOSITION FOR INK JET PRINTER

Commissioner for Patents
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Alexandria, VA 22313-1450

TRANSMITTAL

WARNING: *Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).*

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as
☐ a small entity.
☒ other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Date: September 13, 2006

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run. " Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. § 1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

NOTE: 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 120.00	\$ 60.00
<input type="checkbox"/>	two months	\$ 450.00	\$ 225.00
<input type="checkbox"/>	three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/>	four months	\$ 1,590.00	\$ 795.00
<input type="checkbox"/>	five months	\$ 2,160.00	\$ 1,080.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

						SMALL ENTITY		OTHER THAN A SMALL ENTITY	
(Col. 1)		(Col. 2)		(Col. 3)					
Claims Remaining After Amendment		Highest No. Previously Paid For		Present Extra		Rate		Addit. Fee	
								O R	
Total	*	Minus	**	=	x \$ 25	\$		x \$ 50=	\$
Indep.	*	Minus	***	=	x \$ 100	\$		x \$ 200	\$
<input type="checkbox"/> First Presentation of Multiple Dependent Claims					+ \$ 180=	\$		+ \$ 360=	\$
						Total Addit. Fee	\$ __	O R	Total Addit. Fee \$ __

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
 ** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

OR

- (d) ☐ Total additional fee for claims required \$ _____

FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ _____
☐ Charge Account No. 12-0425 the sum of \$ _____
 A duplicate of this transmittal is attached.

FEE DEFICIENCY OR OVERPAYMENT

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

AND/OR

- ☒ Refund any overpayment to Account No. 12-0425.

Reg. No. 30086

Tel. No. 212-708-1890

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

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New York, N.Y. 10023

Customer No.:



00140

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